

Belersdorf 759-HCL
100718-363
6713-Rshd 98-128

REMARKS

Information Disclosure Statement

U.S. Serial Number 09/640,822 and 09/641,013 could qualify as prior art under 35 U.S.C. 102(e) if patented or published. However, the applications are formally acknowledged as having the same assignee as the present application, i.e. Beiersdorf AG, and is therefore precluded as prior art under 35 U.S.C. 103(c).

35 U.S.C. 103(a) rejection

Claims 1-5 and 7-12 have been rejected over Gers-Barlag et al. (WO 98/42300) in view of Msika (U.S. Patent 5,939,054) and Plaschke (U.S. Patent 6,409,996).

Reply to Examiner's "Response to Arguments"

- (1) The Examiner states that "The property of a compound is inseparable from the compound." (a rough approximation of the language from *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)).

However, later in the section, the Examiner discredits the applicants assertion in their specification that the use of flavone/flavanone/flavanoid compounds was disadvantageous because of their instability by stating that the reference did not so indicate this negative teaching. However, it is irrelevant whether the references teach this negative property or not as "a chemical compound and its properties are inseparable."

To date, the Examiner has not provided the factual basis as to why the applicants teachings are not thought to be true.

- (2) Presuming that any prior art which teaches a water-in-oil system will have an aqueous phase and an oil phase, the applicants invention as it relates to claim 1 requires the simultaneous presence of :

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3. one or more modified phyllosilicate, which exhibits both hydrophilic and lipophilic properties and positions itself at the water/oil interface,
4. one of more flavone, flavanone and/or flavonoid and
5. at most 0.5% by weight of one or more emulsifiers

With regard to the "permutations" argument, what the Examiner has found are the individual elements of the invention but not the rationale for combining the elements especially in light of the applicants' description of the properties of flavone/flavanone/flavanoid compounds.

It is well known that "...virtually all [inventions] are combinations of old elements...Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' *Sensotronics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996)." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

Moreover, when establishing a *prima facie* case of obviousness, both the applicants claims and the disclosures of the prior art must be considered as a whole (see MPEP 2141 - "four tenets of patent law") and such consideration is made by one of ordinary skill in the art without the benefit of the applicants claims as a template. *see In re Fritsch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) - "It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious."

When making this "as a whole" consideration for the cited references, it is readily apparent that while they are directed toward sunscreen formulations, there is almost no commonality with regard to the ingredients which comprise their respective inventions, i.e. one of ordinary skill in the art is reduced to picking and choosing among the necessary elements to arrive at the applicants' invention. *see In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) - "One

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cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”.

Given the number of potential compounds and ingredients that could have been selected from the collection of references cited by the Examiner, there is simply no reason to believe that one of ordinary skill in the art would have been directed to select the combination of elements 3-5 of the applicants' claimed invention from the virtual infinite number of permutations of possible compositions represented by the prior art.

- (3) With each dependent claim, the Examiner's position with regard to the obviousness of the claims in light of Gers-Barlag, Msika and Plaschke becomes ever more progressively weaker. see *MPEP 2143.03* - "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." (see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

The inclusion of Suzuki only further strains the holding of obviousness, i.e. while there is no limitation on the number of references which can be used to support a holding of obviousness, additional references require additional considerations as a whole and greatly complicate finding the requisite motivation to combine the references to the point where it is virtually *prima facie* evidence that elements have merely been collected. In the present case, there is no rationale for inclusion of Suzuki with Gers-Barlag, Msika and Plaschke beyond possessing an element necessary to meet the limitations of the applicants claims as there is no teaching within Suzuki to use glycosyl-rutin generically in any composition as necessary.

For any of the above reasons, it is believed that the claimed invention is unobvious over the prior art and that the Examiner would be justified in withdrawing her rejections.

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Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (8 pages) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 23 July 2004

By: Agata Glinska
Agata Glinska